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OFFICE OF PETITIONS

In re Application of :
Keeth et al. :
Application No. 09/885,217 : DECISION GRANTING PETITION
Filed: 20 June, 2001 :
Attorney Docket No. DB000575-012 :

This is a decision on the renewed petition, bearing a certificate of mailing dated 11 January, 2002, to accord the above-identified application a filing date of 20 June, 2001, rather than the presently accorded filing date of 22 August, 2001.

The petition is **GRANTED**.

On 20 June, 2001, a bundle of papers was deposited in the USPTO, and was assigned Application No. 09/885,217. The papers consisted of, *inter alia*, 232 pages of specification, including Claims 1-80, a signed declaration, and a preliminary amendment, which, *inter alia*, canceled Claims 1-222, 238-246, and 251-465. Accordingly, on 6 August, 2001, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application, stating that the application had not been accorded a filing date because the specification did not include at least one claim, and that page 29 of the specification appeared to have been omitted. The petition filed on 22 August, 2001, was dismissed in a decision mailed on 15 November, 2001.

Upon further review, the Office notes that the preliminary amendment filed on 20 June, 2001, which directed the Office to cancel all existing claims was entered sometime after 16 January, 2002, although the actual date of entry is unknown, since the application was forwarded to the technology center from the Office of Initial Patent Examination on 16 January, 2002. However, on 5 February, 2002, an *Official Gazette* notice, which was signed on 9 January, 2002, was published stating that, in

light of a recent decision by the Federal Circuit,¹ the USPTO will deny entry to any amendment (whether submitted with the filing of the application or after the filing date of the application) that seeks cancellation of all claims without presenting any new or substitute claims.² Therefore, the entry of the preliminary amendment canceling all claims was of no legal force and effect since it was contrary to Office policy. For fee calculation purposes, the USPTO will treat such an application as containing only a single claim.

The preliminary amendment filed on 20 June, 2001, canceling all claims has been unentered. Therefore, the application as filed contained at least one claim and is therefore entitled to a filing date of 20 June, 2001.

Receipt is acknowledged of the preliminary amendment filed by facsimile on 6 March, 2003.

The application is being returned to the Office of Initial Patent Examination for reprocessing with a filing date of 20 June, 2001, and an indication on the bib-data sheet that 1 claim was present on filing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



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¹Exxon Corp. v. Phillips Petroleum Co., 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001).

²See Treatment of Amendments that if Entered Would Cancel All of the Claims in an Application (signed 01/09/02), 1255 OG 827 (Feb. 5, 2002).